

### **REMARKS**

Applicants would like to thank the Examiner for taking the time to discuss the claims and the cited references. Claims 1 and 16 are currently amended and do not add any new matter. Claims 17 and 18 are new and do not add any new matter. Thus, claims 1-18 are pending in the application. This Amendment is in response to the final Office action dated April 6, 2006 and accompanies a Request for Continued Examination (RCE) filed under 37 C.F.R. §1.114 and an Interview Summary.

The final Office action rejected claim 1 under 35 U.S.C. §112 second paragraph. The invention set forth by claims 1-9, 11-12, and 15-16 are alleged not to meet the requirements of 35 U.S.C. §102(e) as being anticipated by U.S. Patent. No. 5,954,640 to Szabo (hereinafter "Szabo"), claim 10 is alleged not to meet the requirements of 35 U.S.C. §103(a) as being unpatentable over Szabo in view of U.S. Patent. No. 5,845,255 to Mayaud, and claims 13 and 14 are alleged not to meet the requirements of 35 U.S.C. §103(a) as being unpatentable over Szabo in view of Official Notice. The applicants respectfully traverse the allegations and respond as follows.

### **SECTION 112 REJECTION**

It is alleged on page 2 of the final Office action that the "so" clause of previous claim 1 failed to particularly point out and distinctly claim the subject matter which applicants regard as their invention. While the applicants believe that previous claim 1 fully met the requirements of 35 U.S.C. §112 second paragraph, in the interest of expediting prosecution, applicants have amended claim 1 to address the Examiner's concern. Specifically, and as agreed to in the interview with the Examiner on July 5, 2006, this claim has been amended to replace the "so" clause with a "wherein" clause and to add additional language to improve its clarity. Applicants respectfully assert that these amendments are strictly to the readability and clarity of the claim and do not narrow the claim in any manner.

Thus, applicants believe that claim 1 meets the requirements of 35 U.S.C. §112 and that the rejection should be withdrawn.

**CLAIMS 1-18 MEET THE  
REQUIREMENTS OF SECTIONS 102(e) AND 103(a)**

The first issue of patentability raised by the Office action, and which the applicants must overcome, is whether each and every limitation of claims 1-9, 11-12, and 15-16 is found in Szabo. The second issue of patentability raised by the Office action concerns the combination of Szabo in view of Mayaud, and whether the combination renders unpatentable claim 10 under 35 U.S.C. §103(a), as well as the combination of Szabo in view of Official Notice, and whether that combination renders unpatentable claims 13 and 14 under 35 U.S.C. §103(a). The applicants submit that claims 1-18 meet the requirements of both 35 U.S.C. §102(e) and 35 U.S.C. §103(a), and therefore, claims 1-18 are allowable. Applicants address the rejections separately as to each independent claim and the claims that depend therefrom.

**§ 102 Rejection based on Szabo**

**Claims 1-9, 11-12, and 15-16**

Amended independent claim 1 is directed to a system for accessing pharmacy data and ordering prescriptions via a network that includes an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities. The system also includes an application server that allows customers to access information concerning drugs and personal information relevant to that specific customer, as well as providing each of the customers with an option to transmit a prescription order to at least one of a plurality of member pharmacies or one of one or more shipping facilities, wherein at least one prescription drug associated with a prescription order is shipped from the one of the one or more shipping facilities when the customer chooses the option to transmit a prescription order to the one or more shipping facilities.

Szabo generally discloses a system providing an optimization of nutritional supplements based on models that allow prediction of a change in health. The Szabo system is particularly focused on nutritional supplements of incompletely or equivocally known value. *Szabo, Col. 1, lines 51-62*. In general, the Szabo system does not appear to disclose working with prescriptions and prescription drugs. Furthermore, Szabo does not disclose incorporating and interconnecting a plurality of member pharmacies into its system.

It is thus respectfully submitted that Szabo does not disclose an intranet server that is connected to at least a plurality of member pharmacies and one or more shipping facilities, nor does it disclose an application server that is configured to provide customers with an option to transmit a prescription order to at least one of the plurality of member pharmacies or one of the one or more shipping facilities, wherein at least one prescription drug associated with the prescription order is shipped from the one of the one or more shipping facilities when the customer chooses the option to transmit a prescription order to the one or more shipping facilities.

While the paragraph in Szabo identified by the Examiner discloses "a link to an on-line ordering system from a nutritional supplement supplier", the identified paragraph, as well as the whole of Szabo, does not disclose an intranet server that is connected to even one shipping facility. *Id.*, at Col. 10, lines 51-62.

It is also submitted that Szabo does not disclose an application server that is configured to provide a customer with an option to transmit a prescription order to at least one of the plurality of member pharmacies or one of the one or more shipping facilities, wherein at least one prescription drug associated with the prescription order is shipped from a shipping facility when the customer chooses the option to transmit a prescription order to the one or more shipping facilities. While Szabo discloses "an ordering system" in Col. 10, lines 59-60, nowhere does Szabo disclose allowing a customer to transmit a prescription order to either a pharmacy or a shipping facility.<sup>1</sup> And in particular, Szabo does not disclose enabling a customer to transmit a prescription order to cause at least one prescription drug associated with the prescription order to be shipped from a shipping facility. This is because it was the inventors of the present invention that were the first to devise a system and appreciate the benefits of providing customers the convenience of placing a prescription order and having the prescription order sent directly to their home, or any other convenient location, without ever having to leave their home or office.

It is critical in pharmacies and pharmaceutical distribution facilities to ensure that licensed pharmacists and technicians handle the filling of prescriptions for distribution to

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<sup>1</sup> The Office action did not point out in particular where Szabo discloses transmitting a prescription order to one of the one or more shipping facilities. If the Examiner disagrees with Applicants' statements of what Szabo does not disclose, she is respectfully invited to point out where such disclosure exists in Szabo.

customers in an appropriate manner. U.S. governmental regulations for operations in pharmacies and pharmaceutical distribution facilities are very rigid and controlled. This is due to the important role that they have in distributing prescription drugs to the U.S. population. The governmental regulations in pharmacies and pharmaceutical distribution facilities necessitate electronic systems such as those disclosed and claimed in the present application, which are markedly different from the systems disclosed in the cited art. Filling a prescription with a wrong drug or even an incorrect dosage can have serious consequences, which may include the death of a patient. This is not the same as when a nutritional supplement system fills an order for an incorrect vitamin. This is why the inventors of the present application sought to develop an electronic prescription ordering system that would reduce risks and ensure patient safety. Thus, as the applicants have explained, existing architectures have not met the needs of efficient, electronic ordering systems within a pharmacy environment.

Because no embodiment of Szabo appears to disclose the invention recited in amended claim 1, it is submitted that amended claim 1 is not anticipated by Szabo<sup>2</sup>. In order for a claim to be anticipated under §102, the anticipating reference must disclose at least one embodiment that incorporates all of the claimed elements. *See for example, C.R. Bard, Inc. v. M3 Systems*, 48 U.S.P.Q.2d 1225, 1230 (Fed. Cir. 1998) ("When the defense of lack of novelty is based on a printed publication that is asserted to describe the same invention, a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device..."); *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990) ("For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference...These elements must be arranged as in the claim under review...").

Therefore, the invention recited in amended independent claim 1 is not anticipated by Szabo. It is respectfully submitted that claim 1 and claims 2-8 which depend therefrom are allowable over Szabo.

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<sup>2</sup> If the Examiner believes there is an embodiment in Szabo that incorporates all of the recitations of one of the claims, she is respectfully invited to point it out and explain how it includes all the recitations of the claim.

### **Claims 9-16**

It is respectfully submitted that Szabo does not disclose a method of enabling one or more customers to order prescriptions and access pharmacy data via a network that includes displaying to a customer on a website at least one of a prescription order selection or a pharmacy data access selection. The method also includes displaying one or more prescription order displays to the customer on the website when the customer selects the prescription order selection wherein the customer is allowed to transmit a particular prescription order to a communication network that connects at least one of a plurality of member pharmacies and one or more distribution facilities, and displaying one or more pharmacy data access displays to the customer when the customer selects the pharmacy data access selection wherein the customer is allowed to access one of a personal prescription history and specific drug information from a database.

As noted in connection with claim 1, there does not appear to be any disclosure in Szabo of (1) enabling one or more customers to order prescriptions and access pharmacy data via a network, (2) displaying to a customer one of a prescription order selection or a pharmacy data access selection, (3) displaying one or more prescription order displays to the customer on a website when the customer selects the prescription order selection wherein the customer is allowed to transmit a particular prescription order to a communication network that connects at least one of a plurality of member pharmacies and one or more distribution facilities; and (4) displaying one or more pharmacy data access displays to the customer when the customer selects the pharmacy data access selection wherein the customer is allowed to access one of a personal prescription history and specific drug information from a database.

Accordingly, it is submitted that claim 9, and claims 10 - 16 which depend therefrom, are not anticipated by Szabo. Regarding dependent claim 16 in particular, applicants respectfully submit that nowhere does Szabo disclose a method that includes a selectable designation by a customer to communicate that a prescription will one of: a) be manually picked up at a selected pharmacy store location; or b) be shipped to a designated postal address. Moreover, it is submitted that the combination of Szabo with Mayaud and Official Notice does not render claims 10 and 13-14 obvious, as there is no disclosure in any of the

cited references that provides motivation to combine them. Likewise, even if the combinations were made, the result would still not be the invention recited in claims 10 and 13-14.

### **Claim 17**

Applicants respectfully submit that none of the cited references disclose a system for accessing pharmacy data and ordering prescriptions via a network that includes *inter alia*: an intranet server that is connected to a first member pharmacy, a second member pharmacy, and a shipping facility; and that includes an application server configured to: allow a customer to access information concerning prescription drugs and personal information concerning that customer, provide each of the one or more customers with an option to transmit a prescription order to the first member pharmacy or the shipping facility; cause at least one prescription drug associated with the prescription order to be shipped from the shipping facility when the customer chooses the option to transmit the prescription order to the shipping facility; and cause at least one prescription drug associated with the prescription order to be filled at the first member pharmacy when the customer chooses the option to transmit the prescription order to the first member pharmacy. For least these reasons, applicants submit that new claim 17 is in condition for allowance.

### **Claim 18**

It is also respectfully submitted that none of the cited references disclose a method enabling a customer to order prescriptions and access pharmacy data via a network that includes *inter alia*: displaying to the customer on the website at least one of a prescription order selection or a pharmacy data access selection; displaying a prescription order display to the customer on the website when the customer selects the prescription order selection wherein the customer is allowed to select to transmit a particular prescription order for a prescription drug to a communication network that connects a plurality of member pharmacies and a distribution facility; wherein the particular prescription order includes a selectable designation by the customer to communicate that the prescription will one of: a) be manually picked up at a selected pharmacy store location; or b) be shipped to a designated

postal address; and displaying a pharmacy data access display to the customer when the customer selects the pharmacy data access selection wherein the customer is allowed to access one of a personal prescription history and specific prescription drug information from a database. For least these reasons, applicants submit that new claim 18 is in condition for allowance.

### CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

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Respectfully submitted,

By 

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